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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,446	09/29/1999	HITOSHI TERASHIMA	64246RCE	2769

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MCGLEW & TUTTLE, PC
P.O. BOX 9227
SCARBOROUGH STATION
SCARBOROUGH, NY 10510-9227

EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/407,446

Applicant(s)

TERASHIMA ET AL.

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-39, 41, 45, 46, 48-52, 54, 56-65 and 67-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-39, 41, 45, 46, 48-52, 54, 56-65 and 67-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/27/04, 11/18/04, 11/15/04, 11/2/06, 1/31/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on October 27, 2004 has been entered.

Allowable Subject Matter

2. The indicated allowability of claims 34-39, 41, 45, 46, 48-52, 54, 56-65 and 67-73 is withdrawn in view of the newly discovered reference(s) to Tajima (Japanese Publication Number 03003030A). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 34-39, 41, 45-46, 48-52, 54, 56-65 and 67-73 rejected under 35 U.S.C. 102(b) as being anticipated by Tajima (Japanese Publication Number 03003030 A).

Concerning claims 34, 46, 49, 50, 52, Tajima discloses an apparatus (1) comprising an image forming apparatus (3), and a scanner (2) which is removably mounted on the image forming apparatus (3) and includes a reading element (2a), a motor (54) and a roller (21) driven by the motor (54); wherein the motor drives the roller to transport a sheet in a case where the scanner is mounted on the forming apparatus (Figs.2, 5) and the scanner reads an original guided by the roller driven by the motor in a case where the scanner is detached from the image forming apparatus ((Fig.1) and a first sheet transporting path (5, 6) is formed substantially vertically to guide a sheet downward on the first sheet transporting path and the reading element reads the sheet in a case where the scanner is mounted on the image forming apparatus, and the image forming apparatus includes a second sheet transporting path (3a, 3b) extending substantially vertically to guide a sheet downward on the second sheet transporting path, the image forming apparatus performs an image forming process for a sheet traveling along the second sheet transporting path; and the first sheet transporting path and the second sheet transporting path are arranged adjacent each other (Figs.1, 5).

Concerning claims 35-38, 41, 45, 48, 51, 59, 60, 61, 62, 63, 64, 67-73, Tajima further teaches that a surface of the scanner on which the reading element is provided faces toward the image forming apparatus in case where the scanner is mounted on the image processing apparatus so that a sheet transporting path is made between a surface of the image forming apparatus and the surface of the scanner (Fig.1), (claims 35, 41, 62); the image forming apparatus a printer (Abstract), (claims 36, 48); the moving direction of a first sheet and the moving direction of a second sheet are same direction (Fig.1), (claim 37); a projecting member is provided on the surface of the scanner for projecting the roller in a case where the scanner runs

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independent of the image forming apparatus (Figs.5-6), (claims 38, 61, 70); a projecting member is provided on the surface of the scanner for protecting the roller in a case where the scanner runs by itself (Figs.5-6), (claim 45); the roller of the scanner apparatus is a pick roller, and the apparatus has a sheet separating member faced to the pick roller in a case where the scanner apparatus is mounted on the image forming apparatus (Figs.5-6), (claims 51, 63, 72); a first sheet transporting path (5-6) is formed substantially vertically to allow the reading element (2) to read the sheet in a case where the scanner is mounted on the base, the base include a second sheet transporting path (3a-3b) extending substantially vertically, the base performs a processing for a sheet traveling along the second sheet transporting path, the first sheet transporting path being arranged along the second sheet transporting path (Figs.1, 2, 5), (claims 59, 67, 68); the scanner has a motor (54) the motor actuates the roller (21) and thereby transports a sheet in a case where the scanner is mounted on the base unit, so that the reading element reads the sheet, and the motor actuates the roller (Figs.5-6), (claim 60); the base unit is an image forming apparatus (printer), (claims 64, 69, 73); .

Concerning claims 39, 58, 67, 71, Tajima discloses the apparatus as discussed in claim 34 wherein the motor actuates the roller to transport a sheet in a case where the scanner is mounted on the image forming apparatus and the scanner reads an original guided by the roller driven by the motor in a case where the scanner is detached from the image forming apparatus; and wherein a surface of the scanner on which the reading element is provided faces toward the image forming apparatus in case where the scanner is mounted on the image processing apparatus so that a sheet transporting path is made between a surface of the image forming apparatus and the surface of the scanner (Fig.1).

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Concerning claim 54, Tajima teaches a first unit (scanner 2) which is capable of being removable mounted on a second unit (1) as discussed in claim 34 above.

Concerning claims 56-57, Tajima discloses an apparatus as discussed in claim 34 above and further comprising a base unit including a sheet accommodating part accommodating a plurality of sheets wherein the sheet accommodating part accommodates the plurality of sheets in a substantially vertical direction (input and output 5-6, 3a-3b).

Concerning claim 65, Tajima discloses a scanner apparatus as discussed in claim 34 above. Tajima further teaches that in a case where the scanner is detached from the base unit, the reading element reads the sheet while the roller travels the scanner with self-running on an original (Figs.2, 5).

Conclusion

5. Claims 34-39, 41, 45-46, 48-52, 54, 56-65 and 67-73 are rejected.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Monday, Tuesday, Thursday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on 571 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Madeleine AV Nguyen', written in a cursive style.

Madeleine AV Nguyen
Primary Examiner
Art Unit 2626

March 2, 2006